

REMARKS

Claims 3-13, 16-21, 24, 26-35, 37, 39, and 41-67 are pending after this amendment.

Applicants have amended claims 3-6, 10, 18, 33, 37, 39, 62 and 63 in order to more particularly define the invention. The amendments were not necessitated by the claim rejections. Applicants make no admission as to the patentability or unpatentability of the originally filed claims.

The amendments and remarks presented herein are in response to the Final Office Action dated August 23, 2006.

The Examiner rejected claims 1 and 2 under 35 USC 101 as being directed to non-statutory subject matter. Claims 1 and 2 have been canceled.

The Examiner rejected claims 1-7, 11, 12, 16, and 17 under 35 USC 102(b) as being anticipated by Dozier. This rejection is respectfully traversed.

Claims 1 and 2 have been canceled.

Claim 3 has been amended to incorporate limitations of its base claim, and to further clarify the nature of the invention. Claim 3 now recites:

“A method of composing a collection of information comprising:
receiving a plurality of paper documents in an order; and
performing at least one action to cause a change to a stored document collection, wherein the at least one action is selected responsive to the order of the documents, and wherein the group of actions comprises at least one selected from the group consisting of:

creating a new collection;
modifying a collection; and
adding a document to a collection.”

As now specifically recited in claim 3, the method includes receiving a plurality of paper documents in an order. Responsive to the order of the documents, an action is selected and performed. The action causes a change in a stored document collection: either creating a new collection, modifying a collection, or adding a document to a collection, or some combination thereof. The present invention thus provides a mechanism by which a user can specify what action should be taken on a document collection simply by providing a stack of paper documents in a particular order. In other words, an advantage of the claimed method is that it avoids any need for user interaction with an on-screen user interface to specify commands and/or actions to be performed.

Nowhere in Dozier is any such technique described. Dozier teaches document authoring, content-based indexing and retrieval of documents, management and publishing of document collections, and support for database operations. However, in all such operations, actions are taken based on user commands specified via a user interface. There is no teaching anywhere in Dozier of performing an action on a document collection responsive to the order of received paper documents, as claimed herein. In fact, Dozier does not even disclose any technique whereby paper documents are received. The word “paper” does not even appear in Dozier in the context of the type of documents being managed. Given that Dozier operates entirely with

electronic documents, the disclosure of Dozier in fact teaches away from receiving and/or using paper documents in the manner claimed herein.

To reiterate the distinction in another way, Applicants provide the following illustrative example of the operation of the method of claim 3. This example is not intended to limit the scope of the claim. A user provides a stack of paper documents; these documents are scanned into a device. One of the documents identifies a collection to be acted upon. Other documents include content to be added to the identified collection. Yet another document indicates another collection to be acted upon. Other documents include modifications to be made to the second collection.

As can be seen from such an example, the order of the documents is highly significant, because those documents that follow the first collection identifier cause actions to be taken on the first collection, while those documents that follow the second collection identifier cause actions to be taken on the second collection. The actions are taken based on the order of the documents, obviating any need for the user to specify actions and targets via a user interface.

By contrast, in Dozier, electronic documents are stored and manipulated based on user commands provided via a user interface rather than responsive to an order of documents. No receipt of paper documents in an order is disclosed. Applicants do not dispute the fact that Dozier may order its documents; however there is no hint of suggestion in Dozier of performing an action that is selected responsive to such an order as claimed herein.

The Examiner states, on p. 51 of the Office Action, that Dozier does teach an action selected responsive to the order of documents. The Examiner cites col. 4, lines 11-26 as teaching setting access controls collectively to a collection of documents. The Examiner states that the access controls are inherently set in an order based on the order of the documents.

However, this section of Dozier is entirely unrelated to selecting or performing an action responsive to an order of received documents. Rather, col. 4, lines 11-26 merely describes a technique for specifying documents to be included in a collection, and performing an operation collectively on each document in the collection. No hint or suggestion is made that such an operation is selected responsive to the order in which the documents were received. In fact, Dozier explicitly states that the operation is performed “by interactively issuing a single command corresponding to the operation.” The fact that Dozier’s operation takes place in response to an issued command implies that such a command needs to be provided to the system by some user interface (an implication that is made explicit elsewhere in Dozier, e.g. at col. 8, lines 14-39); again, this teaches away from any technique where operations are selected based on the order in which documents are presented or received.

Accordingly, claim 3 is respectfully submitted to be patentable over the cited reference.

Claim 4 has been amended to recite receiving documents each comprising at least one piece of paper. Claim 4 also recites “determining whether the first document includes an indicium identifying a collection.” Since the document is a piece of paper, the indicium is, for example, a physical marking on the piece of paper. Action is taken responsive to a determination as to whether the paper document includes an indicium identifying a collection.

Dozier fails to teach any such steps. As described above, Dozier is concerned entirely with electronic documents and does not perform any steps (such as adding an electronic representation of a document to a collection) in connection with paper documents as claimed herein. Furthermore, there is no mention anywhere in Dozier of performing any action responsive to a determination as to the presence of an indicium on a document. The Examiner stated, on p. 52 of the Office Action, that Dozier teaches such steps at col. 8, lines 52-66. However, this portion of Dozier is entirely unrelated to performing an action in response to a determination of the presence of an indicium, as claimed herein. Rather, this portion of Dozier merely discusses hypermedia links from one document to another. The concept of hypermedia links has nothing to do with the steps of the claimed method.

Accordingly, claim 4 is respectfully submitted to be patentable over the cited reference.

Claims 5-7, 11, 12, 16, and 17 depend from claim 4 and incorporate all of the limitations of claim 4 as amended. These claims further recite additional limitations

that render them distinct from the cited reference. Accordingly, for at least the reasons discussed above, these dependent claims are respectfully submitted to be patentable over the cited reference.

The Examiner rejected claims 18-22 and 24-27 under 35 USC 102(b) as being anticipated by Chen. This rejection is respectfully traversed.

Claim 18, which has been amended merely to clarify the nature of the invention, recites:

“A method for adding an annotation to an electronically stored collection of information, comprising:
receiving an annotated media item identifying the electronically stored collection of information, the media item comprising a piece of paper;
reading the annotation from the media item; and
adding the annotation to the electronically stored collection of information.”

An annotated media item comprising a piece of paper is received. The annotated media item identifies an electronically stored collection of information. The annotation is read from the paper media item, and the annotation is added to the electronically stored collection of information. In this manner, a piece of paper can be used to provide both the annotation and the identification of the electronically stored collection to which the annotation is to be added. It is emphasized here that the annotation is added to the collection itself, as recited in the last element of the claim.

Chen fails to teach or disclosure any such method. Chen describes an annotations utility at col. 18, lines 43 to 55. Chen explicitly states that its annotations utility adds notations to a document, but does not mention adding notations to a collection as claimed herein. In addition, there is no mention anywhere in Chen of receiving annotations in the manner recited in the claim, namely on a media item comprising a piece of paper, where the media item also identifies an electronically stored collection of information. Rather, Chen merely describes, in very general terms, a feature that allows a user to manipulate an image document including added annotations upon completion of a scan. Such descriptions fail to teach or suggest any technique even remotely similar to the particular steps claimed herein.

Accordingly, claim 18 is respectfully submitted to be patentable over the cited reference.

Claims 19-21, 24, and 26-27 depend from claim 18 and incorporate all of the limitations of claim 18 as amended. These claims further recite additional limitations that render them distinct from the cited reference. Accordingly, for at least the reasons discussed above, these dependent claims are respectfully submitted to be patentable over the cited reference.

Claims 22 and 25 have been canceled.

The Examiner rejected claims 8-10 and 13-15 under 35 USC 103(a) as being unpatentable over Dozier. This rejection is respectfully traversed.

Claims 8-10 and 13 depend from claim 4 and incorporate all of the limitations of amended claim 4. Accordingly, for at least the reasons discussed above, claims 8-10 and 13 are hereby submitted to be patentable over Dozier. Claims 14-15 have been canceled.

In addition, these claims recite additional limitations not found in Dozier. With respect to claims 8-10, the Examiner states that separators are inherent in any document collection or management system, and that there would otherwise be no way to keep documents whole. On the contrary, in an environment where documents comprise pieces of paper, separators are not inherent. Rather, documents are often kept whole by other means, such as binding, grouping, physical separation, and the like. Furthermore, the examples given by the Examiner are not even applicable to a context where documents comprise pieces of paper, since they refer to EOF and ETX markers and other delineations. Given the many ways that documents can be grouped and/or defined, Applicants respectfully submit that there is no inherency in the notion of separators as asserted by the Examiner.

Furthermore, Applicants respectfully note that the word "separator" does not appear anywhere in Dozier. Nor is there any description in Dozier of a separator being used in the manner claimed herein. Finally, Dozier does not provide any hint or suggestion of using a document as a separator as suggested by the Examiner on p. 17 of the Office Action.

With respect to claim 13, Examiner provides no clear indication as to where in Dozier such scanning steps are described in connection with a collection composition method as claimed herein. Claim 13 clarifies and provides additional recitation as to the mechanism by which documents are received, and further emphasizes that such documents originate as pieces of paper. As discussed above, Dozier is concerned with management of electronic documents rather than paper documents.

The Examiner rejected claims 23 and 28-32 under 35 USC 103(a) as being unpatentable over Chen. This rejection is respectfully traversed.

Claim 23 has been canceled.

Claims 28-32 depend from claim 18 and incorporate all of the limitations of amended claim 18. Accordingly, for at least the reasons discussed above, claims 28-32 are hereby submitted to be patentable over Chen.

Claims 28-32 further recite additional limitations concerning reading the annotation from the media item. For example, claim 28 recites scanning an annotation region, while claim 29 recites performing optical character recognition. Such limitations are not found in Chen.

The Examiner rejected claims 33-37, 39, and 41-67 under 35 USC 103(a) as being unpatentable over Dozier in view of MacPhail and Bergen. This rejection is respectfully traversed.

Claim 33 has been amended to include the limitations of claim 36. Claim 33 now recites:

“A method of providing differentiated access to a collection of information, the method comprising:
generating a first pointer to a collection of information, the first pointer further specifying a first access level from a plurality of access levels;
generating a second pointer to the collection, the second pointer specifying a second access level different from the first access level;
generating a machine-readable indicium representing at least one of the pointers; and
outputting a document including the machine-readable indicium.”

The claimed method provides a mechanism for enabling a first access level for users having a first machine-readable indicium and a second, different access level for users having a second machine-readable indicium. Thus, a first user might be able to read but not edit a collection, while a second user can read and/or edit the collection. The invention enables such a scheme by providing each of the two users with a different document having a machine-readable indicium such as a bar code. Each bar code allows access to the same collection, but the two bar codes allow different levels of access to the collection.

None of the cited references teaches or suggests such a scheme. Dozier fails to teach any method by which two different access levels to the same collection are enabled by two different pointers. Rather, Dozier merely describes document authoring, content-based indexing and retrieval of documents, management and publishing of document collections, and support for database operations. The Examiner stated that Dozier teaches a method of providing differentiated access to a collection of in-

formation, but does not indicate where in Dozier such a teaching can be found. Applicants have reviewed Dozier and have not been able to locate any such teaching therein. In fact, no mention of “access level” or “differentiated” appears anywhere in the description provided by Dozier. At col. 8, lines 35-38, Dozier states that “tools menu 106 performs administrative tasks, such as setting access controls (i.e., costs and security privileges), for collections as a group,” but does not mention any technique for setting such controls in a manner that permits different access levels for different users and outputs documents with machine-readable indicium as claimed herein.

MacPhail also fails to provide any teaching or suggestion of the claim limitations recited herein. MacPhail merely describes methods of retrieving and maintaining a document-in-folder object from an information processing system. Document objects associated with identified documents are identified, and a plurality of operands are built for retrieving data objects. MacPhail describes document library identifiers (LADNs) which are unique names for documents. Document relation object 30 describes logical relationships among documents. However, nowhere in MacPhail is there any mention of providing two (or more) pointers to a collection, each pointer specifying a different access level to the same collection; furthermore, there is no mention in MacPhail of generating a machine-readable indicium and outputting a document including the machine-readable indicium, as claimed herein.

Bergen merely describes a system for managing printing system memory by altering a state of a printing system subsystem by reference to a substrate including a machine readable code. The disclosure of Bergen is wholly unrelated to the subject matter of the present claims. The Examiner asserts that Bergen teaches a security code printed on a machine readable sheet, with such code limited to certain users with permission to access a printer. However, Bergen does not disclose any such machine-readable code for differentiated access to a collection. Rather, the security code of Bergen is intended to provide access to features on a printing machine (col. 9, line 52).

Accordingly, claim 33 is respectfully submitted to be patentable over the cited references, taken alone or in any combination.

Claims 34-35, 37, 39, and 44-55 depend from claim 33 and incorporate all of the limitations of amended claim 33. Accordingly, for at least the reasons discussed above, these claims are hereby submitted to be patentable over the cited references. Claim 36 has been canceled.

Claims 41-43 and 56-63 recite limitations similar to those discussed above in connection with claim 33. Accordingly, for at least the reasons discussed above, these claims are hereby submitted to be patentable over the cited references.

Claim 64 recites:

“A file for specifying access levels, comprising:

at least two resource identifier paths; and
for each of the resource identifier paths, an indication of access rights;
wherein the access rights for a first resource identifier path differ from the access rights for a second resource identifier path pointing to the same resource.”

The claimed invention is a file that provides at least two sets of access rights to the same resource by including at least two resource identifier paths. By facilitating a scheme by which the resource paths indicate the access rights, the claimed invention provides a distinct advantage over prior methodologies: specifically, any interaction with the resource via one of the resource identifier paths can inherently impose the appropriate access rights.

In the Remarks accompanying the previous Amendment, Applicants noted that the Examiner did not provide any explanation for the rejection of claim 64, other than to state that claim 64 incorporates substantially similar subject matter as claimed in claim 41. In response, the Examiner reiterated the rejection but still did not provide any indication as to where in the cited references there is any reference to the claimed subject matter. Instead, the Examiner interpreted the term “resource identifier path” to refer to the computer address of the document. The Examiner also stated, “The ‘relationship between such paths and access rights’ is believed by the Examiner to have been intended by the Applicants to mean that the access rights to the documents accessed the document identifier, which would have been obvious to one of ordinary skill in the art at the time of the invention as a common of accessing a document.” *[Sic.]* Applicant respectfully notes that the quoted language, “relation-

ship between such paths and access rights,” does not appear anywhere in the claims. The Examiner did not provide any guidance as to where the other limitations of claim 64 can be found in the cited references.

As previously stated, none of the cited references provides any mechanism by which two resource identifier paths are used to point to the same resource but with different access rights. In the absence of any indication as to where such a notion purportedly appears in the cited art, Examiner is respectfully requested to withdraw the rejection of claim 63 and the dependent claims (64-67) that incorporate limitations therefrom.

On the basis of the above amendments, consideration of this application and the early allowance of all claims herein are requested.

Should the Examiner wish to discuss the above amendments and remarks, or if the Examiner believes that for any reason direct contact with Applicants’ representative would help to advance the prosecution of this case to finality, the Examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,
John Barrus, Gregory J. Wolff,
Kurt Piersol, Bradley Rhodes and
Stephen Savitzky

Dated: November 20, 2006

By: /Amir H. Raubvogel/
Amir H. Raubvogel
Reg. No. 37,070
Fenwick & West LLP
801 California Street
Mountain View, CA 94041
Phone: (650) 335-7276
Fax: (650) 938-5200